

## REMARKS

This is a full and timely response to the non-final Office Action mailed by the U.S. Patent and Trademark Office on June 11, 2007. Claims 11, 12, 21-23, 26 and 39-41 remain pending in the present application. Claim 11 has been amended. The subject matter of amended claim 11 is illustrated in FIGs. 2C, 7A and 7B and presented in the related detailed description of Applicants' specification. Therefore, no new matter is introduced.

In view of the foregoing amendments and following remarks, reconsideration and allowance of the present application and claims are respectfully requested.

### **Response to Claim Rejections under 35 U.S.C. §103 – Claims 11, 12, 21-23, 26 and 39-41**

#### **A. Statement of the Rejection**

Claims 11, 12, 21-23, 26 and 39-41 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication 20020004246 to Daniels et al. (hereinafter *Daniels*) in view of U.S. Patent No. 6,217,744 to Crosby (hereinafter *Crosby*).

#### **B. Discussion of the Rejection**

For a claim to be properly rejected under 35 U.S.C. § 103, “[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. In order to make a proper *prima facie* case of obviousness; three basic criteria must be met, as set forth in MPEP § 706.02(j). First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure.”

Applicants' independent claim 11, as amended, includes at least one feature that is not disclosed, taught or suggested by the proposed combination of *Daniels* and *Crosby*. Specifically, the combination of *Daniels* and *Crosby* fails to disclose, teach or suggest at least "a terminal located on an external surface of the single-use module for conductively receiving electrical power from a source external to the single-use module for the light source, the first photodetector, and the second photodetector."

Concerning *Daniels*, the Office Action states

"Daniels et al. fail to teach the first and second photodetectors and medium contained in a single-use module that can be inserted into a reusable module and the single use module comprising an external terminal receiving electrical power for the light source, the first and second photodetectors and communicating signals between the reusable module and the single use module."

See Office Action, last sentence of pg. 3 continued on pg. 4.

*Crosby* is cited for its alleged disclosure of a "single use module comprising an external terminal receiving electrical power for the electronics in the device, including light sources and photodetectors (capacitor is external terminal that receives electrical power, col. 8, lines 28-40"). Office Action, pg. 4, first paragraph.

Applicants' claim 11, as amended, includes at least "a terminal located on an external surface of the single-use module for conductively receiving electrical power from a source external to the single-use module for the light source, the first photodetector, and the second photodetector."

In contrast with Applicants' claimed single-use module, *Crosby* shows a device that uses an electrochemical cell to self-power a device.

"A diagram of the electrochemical battery which powers the fluid testing device is shown in FIG. 1A. The system consists of two electrochemical cells made from plates of dissimilar metals separated by a porous membrane. The two cells in the present invention are referred to as the power cell and the wake up cell. Fluid from the introduced sample flows by capillary action from one end along the porous membrane, thus closing the circuit and allowing current to flow. In many applications, the electrolytic components of the body fluid (eg: Na<sup>+</sup>, K<sup>+</sup>, Cl<sup>-</sup>, HCO<sub>3</sub><sup>-</sup>) will be sufficient to activate the cell and provide enough power for the electronics to perform the analysis. However, there

are others where the sample may have insufficient electrolytes, and in this case the cell is manufactured with dried salts deposited on either or both of the electrodes or embedded in the membrane, which dissolve in the introduced fluid, thus completing the basic electrochemical cell.”

*Crosby*, col. 4, lines 51.

An electrochemical cell that self powers a device does not disclose, teach or suggest a terminal located on an external surface of the single-use module for conductively receiving electrical power from a source external to the single-use module for the light source, the first photodetector, and the second photodetector. Accordingly, the proposed combination fails to establish a *prima facie* case of obviousness for at least the reason that the combined teachings of *Daniels* and *Crosby* do not teach all features recited in claim 11.

Accordingly, independent claim 11 is allowable for at least the reason that the claim includes at least one feature that is not disclosed, taught or suggested by the proposed combination.

In addition, the proposed combination of *Daniels* and *Crosby* teaches away from Applicants’ claimed system. The Office Action cites column 7, lines 6-10 in support of the allegation that the device shown in *Crosby* can be placed into the console to provide electrical power. Office Action, pg. 4, first paragraph. Applicants respectfully traverse this interpretation of *Crosby*.

FIG. 4 shows a visual indicator 22 of the best place for locating the disposable analysis device to enable a data transfer. In accordance with column 7, lines 7-10, “an indentation in the console allows the disposable device to be placed and remain there, but in practice anywhere within a few centimeter range will work.” Thus, the cited portion of *Crosby* is entirely silent regarding the provision of electrical power.

In fact, *Crosby* teaches away from the concept of making an electrical connection between the console and the disposable device. In this regard, *Crosby* states:

“[i]t is one of the objects of the present invention to provide communication between the disposable analysis device and an information gathering and storage system such as a

hospital information system. While it would be possible to directly electrically connect the device to a reader (i.e.: with an electrical connector), there are disadvantages of this approach including cost, potential contamination of the connector, need for precise placement in the connector, and power requirements for communication. The present invention uses a different system of communication based on telemetry.”

*Crosby*, column 6, lines 57-67.

The possibility of connecting the disposable analysis device to a storage system with an electrical connector is immediately discounted via the above-referenced list of disadvantages. Furthermore, the cited portion of *Crosby* (column 7, lines 6-10) is describing the best arrangement of the disposable analysis device with respect to the console for transferring data from the disposable device to the console using an inductive coil 17. The cited portion of *Crosby* is entirely silent regarding conductively receiving electrical power from a source external to the single-use module for the light source, the first photodetector, and the second photodetector.

Consequently, independent claim 11 is allowable for at least the additional reason that the proposed combination teaches away from Applicants’ claimed system.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 11 under 35 U.S.C. §103(a) are respectfully requested.

Because independent claim 11 is allowable, dependent claims 12, 21-23, 26 and 39-41, which depend directly or indirectly from allowable independent claim 11, are allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1998). Accordingly, favorable reconsideration and withdrawal of the rejection of dependent claims 12, 21-23, 26 and 39-41 under 35 U.S.C. §103(a) are respectfully requested.

**CONCLUSION**

Applicants respectfully submit that pending claims 11, 12, 21-23, 26 and 39-41 are allowable and that the present application is in condition for allowance. Accordingly, a Notice of Allowance is respectfully solicited. Should the Examiner have any comments regarding the Applicants' response, Applicants request that the Examiner telephone Applicants' undersigned attorney.

Respectfully submitted,

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